

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

EXPRESS MAIL NO. EL904793163US

Applicant : Roy J. Mankovitz, et al.
Application No. : to be assigned
Filed : July 23, 2001
Title : APPARATUS AND METHODS FOR A TELEVISION ON-SCREEN
GUIDE
Docket No. : 45653/JEC/E190

PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Post Office Box 7068
Pasadena, CA 91109-7068
July 23, 2001

Commissioner:

Prior to the examination of the above-identified application, please amend the application as follows.

In the Specification:

Please replace the paragraph beginning on page 1 lines 6-10 with the following paragraph:

This is a continuation of pending patent application serial No. 09/862,199, filed May 23, 1997, which is a continuation-in-part of patent application serial No. 08/368,340, filed December 30, 1994 (now U.S. Patent No. 5,659,367), which is a continuation-in-part of patent application serial No. 08/364,708 filed December 28, 1994 (now U.S. Patent No. 5,640,484). The subject matter of all of the above referenced patent applications, continuation and continuation-in-part applications are incorporated herein by this reference, as though set forth in full.

REMARKS

Claims 1-8 are pending in this application. By this preliminary amendment, Applicant has amended the section of the specification entitled "Cross Reference to Related Applications" to claim priority of the parent application Ser. No. 09/862,199. In view of the above amendments and remarks that follow, Applicant respectfully requests a timely indication of allowance of claims 1-8.

Claims 1-4 correspond to claims 15-18 of the parent application. In the final Office Action of the parent case, the Examiner rejected claims 15-18 (now renumbered as claims 1-4) under the doctrine of double patenting over claims 1-32 of U.S. Patent No. 5,640,484 (the '484 patent) because the pending claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The Examiner agrees that the claims in the '484 patent do not disclose the compiling of a list of one or more guides from the stored guide identifiers, displaying the list of guides, selecting a guide from the displayed list of guides for future reception of the selected guide, and storing the guide identifier for the selected guide recited in claims 1-4. However, the Examiner contends that the combination of claims 1-32 of the '484 patent and Klosterman, U.S. Patent No. 5,640,484, discloses these features. Applicant respectfully disagrees.

At a minimum, Klosterman fails to teach the displaying of the list of guides for viewer selection. In fact, the Examiner has provided no support that Klosterman in fact teaches this feature.

Klosterman also fails to teach the selecting of a guide for future reception. Although the Examiner relies on columns 8-9 of Klosterman for support, there is nothing in this portion or any other portion of the disclosure to teach or suggest receiving television guide from different sources and allowing the user to select one of them for future reception.

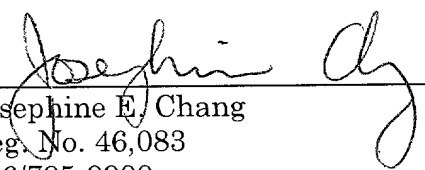
In view of the foregoing, a timely indication of allowance of claims 1-8 is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By


Josephine E. Chang
Reg. No. 46,083
626/795-9900

JEC/daa

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Cross-Reference to Related Applications:

The paragraph beginning on page 1 lines 6-10 has been amended as follows:

This is a continuation of pending patent application serial No. 09/862,199, filed May 23, 1997, which is a continuation-in-part of [pending] patent application serial No. 08/368,340, filed December 30, 1994 (now U.S. Patent No. 5,659,367), which is a continuation-in-part of [pending] patent application serial No. 08/364,708 filed December 28, 1994 (now U.S. Patent No. 5,640,484). The subject matter of all of the above referenced patent applications, continuation and continuation-in-part applications are incorporated herein by this reference, as though set forth in full.

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